

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

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MISFITS A.D., LLC	:	
	:	Case No.: <u>20-cv-2093</u>
Plaintiff,	:	
	:	
-against-	:	
	:	<u>COMPLAINT</u>
HARRY N. ABRAMS, INC.,	:	JURY TRIAL DEMANDED
	:	
Defendant.	:	
	:	
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Plaintiff Misfits A.D., LLC (“Misfits A.D.”), by its attorneys, for its Complaint against Defendant Harry N. Abrams, Inc. (“Abrams”), alleges as follows:

SUMMARY OF THE CASE

1. By this action, Misfits A.D. seeks injunctive relief and monetary damages arising from Abrams’ unlawful exploitation of Misfits A.D.’s valuable intellectual property. Specifically, Abrams has willfully infringed Misfits A.D.’s famous “Fiend Skull design” trademark and has unlawfully copied and used Misfits A.D.’s copyrighted artwork in connection with the advertising and sale of a photobook entitled “Scream With Me -- The Enduring Legacy of the Misfits.”

2. The Misfits are a seminal punk rock band, widely recognized as the founders of the horror punk subgenre that combined punk rock music with horror imagery.

3. The instantly recognizable logos and artwork associated with the Misfits, including the iconic and federally registered “Fiend Skull design” trademark and its album artwork, was and remains an integral part of the band’s artistic brand and a critical component of its success and global popularity.

4. Seeking to improperly and unfairly capitalize on the Misfits' creative output and success, Abrams has released an unauthorized photobook that purports to depict the "visual history" of the Misfits.

5. Abrams' photobook is rife with large-scale, repeated, and unlicensed reproductions of Misfits A.D. intellectual property. For example, the cover of the photobook prominently displays, without authorization, the Misfits A.D. "Fiend Skull design" trademark and, in doing so, misleads consumers into believing that the photobook has been approved by, or is associated with, Misfits A.D., which is indisputably false. The photobook also unabashedly copies wholesale copyrighted artwork associated with the Misfits' musical recordings and releases. The Misfits' copyrighted artwork is an integral part of the band's extensive and highly successful line of officially licensed merchandise and its world famous lifestyle brand. In addition, the named authors of the infringing photobook have been falsely affiliating themselves with the Misfits in connection with advertising and promoting the publication and release of the book, further harming Misfits A.D.

6. Abrams' conduct as described more fully herein constitutes copyright infringement in violation of the Copyright Act, 17 U.S.C. §§ 106 and 501, and trademark infringement and unfair competition in violation of the Lanham Act, 15 U.S.C. § 1051, *et. seq.* Accordingly, Misfits A.D. brings this action to protect its rights, stop Abrams' deception of the consuming public, and enjoin Abrams from its continued violations of the Misfits A.D.'s intellectual property rights.

PARTIES

7. Plaintiff Misfits A.D. is a limited liability company organized under the laws of the State of Delaware. Misfits A.D., among other things, owns and manages intellectual property, including trademarks and copyrights, associated with the Misfits.

8. Upon information and belief, Defendant Abrams is a corporation organized under the laws of the State of New York, with its principal place of business located at 195 Broadway, Ninth Floor, New York, NY, 10007.

JURISDICTION AND VENUE

9. This Court has original jurisdiction over the subject matter of the claims brought herein under the Copyright Act, 17 U.S.C. § 501, and the Lanham Act, 15 U.S.C. § 1051, *et. seq.* pursuant to 28 U.S.C. §§ 1331, 1338 and 15 U.S.C. § 1121.

10. Abrams is subject to personal jurisdiction in this judicial district because it is a corporation organized under the laws of the State of New York with its principal place of business in this district.

11. Venue for this action is proper in this judicial district pursuant to 28 U.S.C. §§ 1391 and 1400 because Abrams resides in this district.

FACTS

A. The Misfits

12. In 1977, Glenn Danzig (“Danzig”) and Gerard Caiafa, professionally known as Jerry Only (“Only”), formed a punk rock band named the “Misfits.” The original “Misfits” performed together until the band disbanded in 1983.

13. Danzig served as the band’s songwriter and lead singer; Only was its bass guitarist.

14. The Misfits developed a unique persona, look, and sound by immortalizing black and white B horror films in their loud, aggressive, and confrontational music, their ghoulish, monster-like stage appearances, and the distinctive, instantly-recognizable logos and artwork associated with the band.

15. Between 1977 and 1983, the Misfits released multiple singles, EPs, and full-length albums.

16. Danzig created, and was the initial copyright owner of original artwork, including cover art, booklet design and the general packaging, for each of those releases.

17. In those six years, the band also toured extensively, developing a dedicated fan base.

18. Since the Misfits disbanded in 1983, the band's popularity has steadily increased.

19. The Misfits are frequently cited as a key influence on later punk rock and heavy metal music, including such monumental artists as Metallica and Guns 'n Roses.

20. As a result of the continual efforts of Misfits A.D.'s predecessors-in-interest to develop and increase the goodwill associated with the Misfits' music, name, logos, artwork and other intellectual property over the course of the past several decades, demand for the Misfits products, including products bearing the Misfits original artwork and "Fiend Skull design" trademark, steadily increased, along with the band's popularity, throughout the three decades after the Misfits disbanded.

21. In 2016, Danzig and Only reunited to tour as "The Original Misfits," and have since played a series of highly publicized and critically acclaimed shows around the country, including in Los Angeles, Las Vegas, Denver, Chicago, Philadelphia, and New York City.

22. On October 19, 2019, The Original Misfits performed as the headlining act at a sold-out show in Madison Square Garden in New York City. It was the first time a punk band ever headlined a show at Madison Square Garden.

B. Misfits A.D. Intellectual Property

23. Danzig and Only formed Misfits A.D. to conduct activities related to The Original Misfits reunion, including managing the Misfits' intellectual property.

24. Misfits A.D. is the owner by assignment of all right, title, and interest in and to the following registered copyrighted works (collectively, “the Misfits Artwork”):

- (1) “Bullet” 7-inch art -- Copyright Registration No. VA 2-176-263
- (2) “Beware” EP art -- Copyright Registration No. VA 2-185-512
- (3) “Halloween” 7-inch art -- Copyright Registration No. VA 2-176-934
- (4) “Earth AD” album art -- Copyright Registration No. VA 2-180-542
- (5) “Collection I” album art -- Copyright Registration No. VA 2-180-543

25. The Misfits Artwork consists of original elements that are indelibly linked with the band including, for example, the Misfits “Horror Font” and Fiend Skull logos.

26. True and correct copies of the Misfits Artwork are attached hereto as Exhibit 1.

27. True and correct copies of the U.S. Copyright Office certificates of registration for the Misfits Artwork are attached hereto as Exhibit 2.

28. In connection with its Misfits-related activities, Misfits A.D. also is the exclusive owner by assignment of U.S. Registration No. 2,770,984 for the “Fiend Skull design” (the “FIEND SKULL mark”) for various goods.

29. Misfits A.D.’s registration for the FIEND SKULL mark is valid and subsisting.

30. Misfits A.D., itself and through its predecessors-in-interest, has exploited and continues to actively exploit its rights in the FIEND SKULL mark through the sale of myriad types of merchandise. As a result, Misfits A.D. has established strong trademark rights in the FIEND SKULL mark in indelible association with Misfits-related goods and services.

31. Misfits A.D., and its predecessors-in-interest, have expended considerable amounts of time and money to develop, promote and otherwise build goodwill in the Misfits and the FIEND SKULL mark, and to associate and brand the FIEND SKULL mark exclusively with the Misfits.

32. The goodwill, popularity, and recognition of the Misfits and the FIEND SKULL mark is the direct result of Misfits A.D.'s, and its predecessors-in-interest's, development, marketing, and promotion of the Misfits and the FIEND SKULL mark and the substantial time and money investment made by Misfits A.D. and its predecessors-in-interest. This goodwill, popularity, and recognition are precisely why Abrams has chosen to exploit and trade on Misfits A.D.'s FIEND SKULL mark in connection with its infringing photobook.

C. Abrams' Infringement of Misfits A.D. Intellectual Property.

33. Abrams publishes art and illustrated books in the areas of art, photography, cooking, craft, comics, interior and garden design, entertainment, fashion, and popular culture.

34. In or around July 2019, Abrams announced that it planned to release a "coffee-table" format photobook titled *Scream With Me: The Enduring Legacy of The Misfits*, by Tom Bejgrowicz and Jeremy Dean ("Book").

35. A true and correct copy of a screenshot of the Abrams webpage advertising the Book is attached hereto as Exhibit 3.

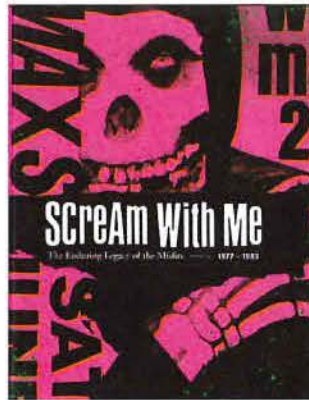
36. In addition to advertising the Book, Abrams began taking pre-orders for the Book in or around the same time through at least Abrams' own website, Amazon, Barnes & Noble, and Target, among other U.S. retailers.

37. While Abrams originally advertised that the Book would be released in December 2019, Abrams, in November 2019, pushed the release date back to February 25, 2020.

38. Despite revising the advertised release date, Abrams actually published the Book on December 17, 2019, just three days after The Original Misfits played the Wells Fargo Center in Philadelphia and on the heels of The Original Misfits' historic sold out show in Madison Square Garden.

39. The Book is available in hardcover and e-book formats, with a list price of \$30 for the hardcover edition.

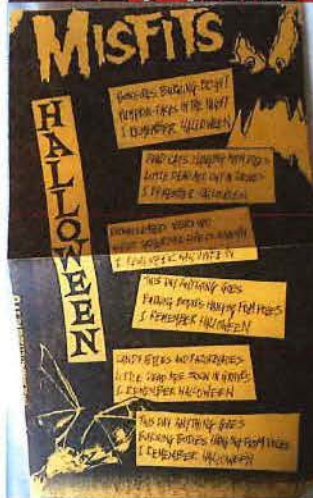
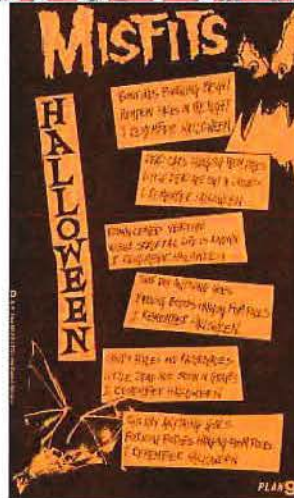
40. The cover of the Book, reproduced below, prominently displays Misfits A.D.'s FIEND SKULL mark, along with countless additional uses of the FIEND SKULL mark and other Misfits intellectual property inside the book. At no time has Misfits A.D. given Abrams a license or other form of express or implied approval or consent for Abrams' use of the FIEND SKULL mark in connection with the Book.



41. Abrams' unauthorized copying of the FIEND SKULL mark as the main image on the cover of the Book is likely to cause confusion and lead consumers to mistakenly believe that Abrams and the Book are endorsed, approved, or sponsored by, or affiliated, connected, or associated with Misfits A.D.

42. In addition to the infringing cover of the Book, the Book is structured around the Misfits Artwork with chapters that consist entirely of unauthorized uses of the Misfits Artwork, with each of the Misfits Artwork reproduced multiple times on multiples pages of the Book and using both exact copies and variants of the Misfits Artwork.

43. By way of example, the "Halloween" 7-inch pages in the Book reproduce Misfits Artwork in large scale, taking up the bulk of the two page spread and bearing only small text labels identifying the displayed Misfits Artwork:

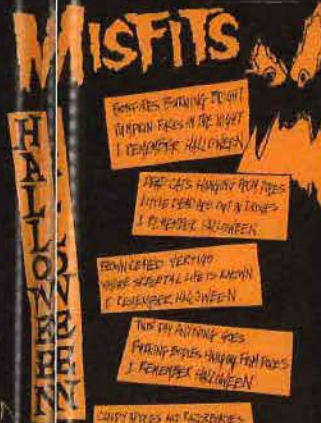


The image is the cover of the Misfits' 'Halloween' album. It features a black and white photograph of the four band members in a dark, horror-themed setting. The word 'MISFITS' is written in large, white, distressed capital letters at the top. The word 'HALLOWEEN' is written vertically in large, white, distressed capital letters on the left side. The entire cover is framed by a border of small, white, distressed skulls. In the bottom right corner, there is a large, orange pumpkin with a carved face.

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RELEASER: MISTIS
DISTRIBUTOR: MISTIS
COUNTRY OF ORIGIN: MISTIS
COUNTRY OF RELEASE: MISTIS



RECOGNIZED VERY GOOD
WAS RECOGNIZED AS TO KNOW
I REMEMBER HOW GREEN

NO TWO ANYTHING DOES
FINDING BONES AND FINDING BONES
I REMEMBER HOW GREEN

CANDY APPLES AND CANDY APPLES
LITTLE BONES ARE BONES & BONES
I REMEMBER HOW GREEN

NO TWO ANYTHING DOES
FINDING BONES AND FINDING BONES
I REMEMBER HOW GREEN



In 1981 I met Jerry at Calicut at Club 57 because they said they had to see me because they had a surprise for me. I hadn't the slightest idea what the surprise could be and was hoping it was a show—Jerry had had a put out at one point but I think the health department took it away from him. They gave me a bag pressing of their record "Hallucinate." It was destined to me. What a thrill and an honor! There is an incredible beauty among Moslems, Moslems, Chik medians.

Series Numbered Name: Wye C. 20

44. Abrams itself concedes that the purpose of the Book is to usurp the value of the Misfits Artwork, having advertised the Book as a “visual history” of the Misfits that “spotlights the band’s iconic and influential album and single art, fan club merchandise, original posters, [and] show flyers” *See* Exhibit 3.

45. Misfits A.D. has not authorized Abrams to use the Misfits Artwork in the Book.

D. Abrams Refuses To Cease and Desist Its Infringement.

46. Prior to announcing the release of the Book, neither Abrams nor its authors made any effort to contact Misfits A.D., Danzig, or Only regarding the planned release or to seek permission to use the FIEND SKULL mark or Misfits Artwork in the Book.

47. Upon information and belief, Abrams knew prior to announcing the release of the Book that the Book infringed the FIEND SKULL mark and copyrights in the Misfits Artwork.

48. Upon learning of Abrams’ planned release of the Book, Misfits A.D.’s counsel wrote to Abrams to demand that Abrams cease and desist from promoting, advertising or selling the infringing Book.

49. In response, Abrams admitted that it obtained clearances from other copyright holders for the foreword, interviews, quotes, and certain photographs contained in the Book.

50. Nonetheless, Abrams categorically denied that it needed clearance or authorization to use the FIEND SKULL mark or to use and/or make derivative works of the Misfits Artwork in the Book.

E. Abrams Is Causing Irreparable Harm to Misfits A.D.

51. Misfits A.D. has taken on from Danzig and Only an extensive licensing program for Misfits merchandise.

52. The FIEND SKULL mark and Misfits Artwork are among the intellectual property licensed to third parties through that program.

53. Abrams' unlicensed use of the FIEND SKULL mark and Misfits Artwork interferes with Misfits A.D.'s right to exploit its intellectual property rights in the FIEND SKULL Mark and the Misfits Artwork through its licensing program.

54. For example, for over thirty years, Danzig and Only have been collecting documentary materials related to the Misfits, including materials depicted in the Book.

55. Using the materials they have collected, Danzig and Only intend to release, through Misfits A.D., a biographical picture book detailing the history of the Misfits.

56. Abrams' Book interferes with the market for Misfits A.D.'s intended release of its own material.

57. Additionally, Misfits A.D. has lost its exclusive right and ability to control and/or determine the manner, appearance, timing, location, content and image of its FIEND SKULL mark, which has harmed Misfits A.D. and its predecessors-in-interest who have invested, and continue to invest, considerable resources in connection with protecting the goodwill and exclusivity associated with the FIEND SKULL mark.

58. Conversely, Abrams has, and continues to, unlawfully and unjustly benefit from its misappropriation and exploitation of the FIEND SKULL mark and Misfits Artwork without Misfits A.D.'s approval or consent.

59. In addition, Tom Bejgrowicz and Jeremy Dean, the authors of the Book, have falsely associated, and continue to falsely associate, themselves and Umberto D'Urso with The Misfits in interviews and other publicity for the Book. Misfits A.D. has no affiliation with any of those individuals and does not endorse them or the Book.

60. Misfits A.D.'s interest in protecting its intellectual property rights from consumer confusion and unlawful copying outweighs any potential harm to Abrams and the public interest is best served by preventing such confusion and unlawful copying.

61. Because of Abrams' ongoing and continuous violations of Misfits A.D.'s rights in the FIEND SKULL mark and Misfits Artwork, Misfits A.D. seeks injunctive relief from this Court enjoining Abrams from using, copying, exploiting or in any way trading on the FIEND SKULL mark and Misfits Artwork. Separately, Misfits A.D. seeks to recover damages including, but not limited to, a disgorgement of Abrams' profits, arising from Abrams' violations of Misfits A.D.'s intellectual property rights.

CAUSES OF ACTION

COUNT I

Copyright Infringement (17 U.S.C. § 501)

62. Misfits A.D. repeats and incorporates by reference all of the foregoing paragraphs as if fully set forth herein.

63. Misfits A.D. is the owner by assignment of the copyrights in the Misfits Artwork. The U.S. Copyright Office issued the copyright registrations for the Misfits Artwork on the dates reflected on the copyright registration certificates attached hereto as Exhibit 2.

64. By engaging in unauthorized reproduction of the Misfits Artwork and the creation of derivative works thereof in the Book, Abrams has infringed Misfits A.D.'s copyrights in the Misfits Artwork in violation of the Copyright Act, 17 U.S.C. § 501.

65. Abrams' acts of infringement are willful, intentional and purposeful, in disregard of and with indifference to the rights of Misfits A.D.

66. Misfits A.D. has been injured and continues to be injured as a direct and proximate result of Abrams' infringement.

67. Misfits A.D. has no adequate remedy at law for the substantial and irreparable injury caused to it by Abrams' infringement. Upon information and belief, unless enjoined by this Court, Abrams will continue to infringe Misfits A.D.'s copyrights, including through the publication of the Book. Misfits A.D. is entitled to injunctive relief pursuant to 17 U.S.C. § 502 to enjoin Abrams from continuing its infringing conduct.

68. Additionally, Misfits A.D. is entitled either to statutory damages or to its actual damages and Abrams' profits attributable to the infringement pursuant to 17 U.S.C. § 504, and will make an election prior to a final judgment being rendered.

69. Misfits A.D. also is entitled to costs and attorneys' fees pursuant to 17 U.S.C. §505.

COUNT II
Trademark Infringement (15 U.S.C. § 1114)

70. Misfits A.D. repeats and incorporates by reference all of the foregoing paragraphs as if fully set forth herein.

71. Misfits A.D. is the owner by assignment of the federally-registered FIEND SKULL mark as described herein. The FIEND SKULL mark is currently in full force and effect.

72. Abrams' unauthorized use of Misfits A.D.'s FIEND SKULL mark in connection with Abrams' business activities and sale of the Book is likely to cause confusion and mistake among consumers that (a) Abrams and/or its goods originate with Misfits A.D., (b) there is some affiliation, connection or association between Abrams and/or its goods and Misfits A.D., and/or (c) Abrams and/or its goods are being offered to consumers with the sponsorship and/or approval of Misfits A.D. Misfits A.D. has been substantially injured as a result.

73. The aforementioned acts of Abrams were and are willful and intentional and undertaken in a deliberate effort to cause confusion and mistake among the consuming public as

to the source, affiliation and/or sponsorship of said goods, and to gain for Abrams the benefit of the enormous goodwill associated with Misfits A.D.'s FIEND SKULL mark.

74. Abrams has engaged in trademark infringement in violation of § 32 of the Lanham Act, 15 U.S.C. § 1114.

75. The threat of the loss of Misfits A.D.'s right to control and exploit the use of its FIEND SKULL mark and the substantial reputation, goodwill, and indelible association with Misfits A.D. of its goods is real and substantial.

76. Abrams' misconduct has injured Misfits A.D. in an amount to be determined at trial. Abrams' misconduct also has caused and will continue to cause irreparable injury to Misfits A.D., for which Misfits A.D. has no adequate remedy at law.

COUNT III

False Designation of Origin and Unfair Competition Under Section 43(a) of the Lanham Act (15 U.S.C. § 1125)

77. Misfits A.D. repeats and incorporates by reference all of the foregoing paragraphs as if fully set forth herein.

78. Misfits A.D. is the owner by assignment of the federally-registered and common law rights in the FIEND SKULL mark as described herein.

79. Abrams has made use of the FIEND SKULL mark, and/or other words, terms, names, symbols or devices (including, among other things, the Misfits' FIEND CLUB design and logo), or any combination thereof, as a false designation of origin, false or misleading descriptions of fact, and/or false or misleading representations of fact which are likely to cause confusion and mistake among consumers that (a) Abrams and/or its goods originate with Misfits A.D., (b) there is some affiliation, connection or association between Abrams and/or its goods and Misfits A.D.,

and/or (c) Abrams and/or its goods are being offered to consumers with the sponsorship and/or approval of Misfits A.D., all in violation of § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

80. The aforementioned acts of Abrams were and are willful and intentional and undertaken in a deliberate effort to cause confusion and mistake among the consuming public as to the source, affiliation and/or sponsorship of said goods, and to gain for Abrams the benefit of the enormous goodwill associated with Misfits A.D.'s FIEND SKULL mark.

81. The threat of the loss of Misfits A.D.'s right to control and exploit the use of its FIEND SKULL mark and the substantial reputation, goodwill, and indelible association with Misfits A.D. of its goods is real and substantial.

82. Abrams' misconduct has injured Misfits A.D. in an amount to be determined at trial. Abrams' misconduct also has caused and will continue to cause irreparable injury to Misfits A.D., for which Misfits A.D. has no adequate remedy at law.

PRAYER FOR RELIEF

WHEREFORE, Misfits A.D. respectfully requests that this Court:

A. Enjoin Abrams, including all partners, officers, agents, servants, employees, attorneys, and all those persons and entities in active concert or participation with it, from infringing Misfits A.D.'s FIEND SKULL Mark and Misfits Artwork copyrights in connection with any products published, marketed, or sold by Abrams, including, but not limited to, the Book.

B. Enter an order that Abrams' trademark and copyright infringement, false designation of origin and unfair competition was willful.

C. Direct Abrams to pay Misfits A.D. all damages sustained by Misfits A.D. as a result of Abrams' wrongful acts of trademark infringement, false designation of origin and unfair competition and trebling such damages because Abrams' acts were willful.

D. Order an accounting and disgorgement of all of Abrams' profits realized by its wrongful acts of trademark infringement, false designation of origin and unfair competition and trebling such damages because Abrams' acts were willful.

E. Based on its election, either awarding (i) Misfits A.D.'s actual damages and Abrams' profits attributable to its infringement of Misfits A.D.'s copyrights in the Misfits Artwork or (ii) statutory damages for Abrams' willful copyright infringement of the Misfits Artwork.

F. In the event that Misfits A.D. elects to seek Misfits A.D.'s actual damages and Abrams' profits attributable to its copyright infringement, enter an order for an accounting of, and the imposition of a constructive trust with respect to, Abrams' profits attributable to its infringements of Misfits A.D.'s copyrights in the Misfits Artwork.

G. Enter an order for prejudgment interest according to law.

H. Direct Abrams to pay Misfits A.D.'s attorneys' fees, costs, and disbursements in this action.

I. Award Misfits A.D. such further relief as this Court may deem just and proper.

JURY TRIAL DEMAND

Misfits A.D. hereby demands a trial by jury on all issues so triable.

Dated: March 9, 2020

Respectfully submitted,

K&L GATES LLP

By:

/s/

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